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In re Application of:

SLEZAK, ARNOLD G.

Serial No.: 09/981,556

Filed: Oct. 17, 2001

Docket: P1535US01

DECISION ON PETITION

Title: METHOD TO REDUCE SERVO
PATTERN RUNOUT ON A
PREWRITTEN DISC

This is a decision on the petition filed on Nov. 21, 2006 by which petitioner respectfully requests withdrawal of the restriction requirement made FINAL in the Office action dated Aug. 22, 2005 and that claims 25-33 be examined in this application. This petition is being considered pursuant to 37 CFR 1.144 and 37 CFR 1.181.

The petition is DISMISSED.

The record shows that:

- 1) On Apr. 22, 2005, the examiner issued a restriction requirement grouping claims 1-9 and 21-24 (Group I) to a process of making a disc drive, claims 25-29 (Group II) to a product of a disc drive, and claims 30-33 (Group III) to a product of a disc stack with a servo motor. Claims 10-20 remained withdrawn from further consideration pursuant to 37 CFR 1.142(b), as being drawn to a nonelected invention, there being no allowable generic or linking claim.
- 2) On May 31, 2005, the petitioner made an election with traverse and elected the group including claims 1-9 and 21-24 drawn to a process of making a disc drive. In addition petitioner amended independent claims 1 and 25.
- 3) On Aug. 22, 2005, the examiner made the restriction requirement final in a non-final Office action.
- 4) On Nov. 22, 2005, the petitioner filed a response to the non-final Office action with no amendments to the claims. The petitioner again traversed the restriction requirement.

- 5) On Mar. 1, 2006, the examiner issued a second non-final Office action. In the second non-final Office action, the examiner maintained the finality of the restriction requirement dated Apr. 22, 2005.
- 6) On May 31, 2006, the petitioner filed an amendment to non-elected claim 30. The petitioner also argued that the restriction requirement was improper.
- 7) On Aug. 21, 2006, the examiner issued a final Office action. The examiner also presented arguments maintaining the finality of the restriction requirement dated Apr. 22, 2005.
- 8) On Oct. 20, 2006, the petitioner filed an amendment under 37 CFR 1.312 to claim 1 and also argued that the restriction requirement was improper.
- 9) On Nov. 7, 2006, the examiner issued an advisory action refusing entry of the after final amendment filed Oct. 20, 2006 since the amendment to claim 1 raised new issues that would require further consideration and/or search.
- 10) On Nov. 21, 2006, the petitioner filed the current request to withdraw the restriction requirement made FINAL in the Office action dated Aug. 22, 2005 and that claims 25-33 be examined in this application.
- 11) On Jan. 22, 2007, the petitioner filed an appeal brief.

Discussion and analysis

MPEP 806.05(f) Process of Making and Product Made, states:

A process of making and a product made by the process can be shown to be distinct inventions if either or both of the following can be shown: (A) that the process *as claimed* is not an obvious process of making the product and the process *as claimed* can be used to make another materially different product; or (B) that the product *as claimed* can be made by another materially different process. Allegations of different processes or products need not be documented. A product defined by the process by which it can be made is still a product claim (*In re Bridgeford*, 357 F.2d 679, 149 USPQ 55 (CCPA 1966)) and can be restricted from the process if the examiner can demonstrate that the product *as claimed* can be made by another materially different process; defining the product in terms of a process by which it is made is nothing more than a permissible technique that applicant may use to define the invention. If applicant convincingly traverses the requirement, the burden shifts to the examiner to document a viable alternative process or product, or withdraw the requirement. Form paragraphs 8.18 and 8.21.04 should be used in restriction requirements between product and process of making.

MPEP 806.05(d) Subcombinations Usable Together, states:

Two or more claimed subcombinations, disclosed as usable together in a single combination, and which can be shown to be separately usable, are usually restrictable when the subcombinations do not overlap in scope and are not obvious variants. To support a restriction requirement where applicant separately claims plural subcombinations usable together in a single combination and claims a combination that requires the particulars of at least one of said subcombinations, both two-way distinctness and reasons for insisting on restriction are necessary. Each subcombination is distinct from the combination *as claimed* if: (A) the combination does not require the particulars of the subcombination *as claimed* for patentability (e.g., to show novelty and unobviousness), and (B) the subcombination can be shown to have utility either by itself or in another materially different combination. See MPEP § 806.05(c). Furthermore, restriction is only proper when there would be a serious burden if restriction were not required, as evidenced by separate classification, status, or field of search. Where claims to two or more subcombinations are presented along with a claim to a

combination that includes the particulars of at least two subcombinations, the presence of the claim to the second subcombination is evidence that the details of the first subcombination are not required for patentability (and vice versa). For example, if an application claims ABC/B/C wherein ABC is a combination claim and B and C are each subcombinations that are properly restriktbare from each other, the presence of a claim to C provides evidence that the details of B are not required for the patentability of combination ABC. Upon determining that all claims directed to an elected combination invention are allowable, the examiner must reconsider the propriety of the restriction requirement. Where the combination is allowable in view of the patentability of at least one of the subcombinations, the restriction requirement between the elected combination and patentable subcombination(s) will be withdrawn; furthermore, any subcombinations that were searched and determined to be allowable must also be rejoined. If a subcombination is elected and determined to be allowable, nonelected claims requiring all the limitations of the allowable claim will be rejoined in accordance with MPEP § 821.04. Form paragraph 8.16 may be used in restriction requirements between subcombinations.

In the restriction requirement dated Apr. 22, 2005, the examiner grouped the claims as follows:

Group I: Claims 1-9 and 21-24, drawn to a process of making a disc drive

Group II: Claims 25-29, drawn to a product of a disc drive

Group III: Claims 30-33, drawn to a product of a disc stack with a servo motor

The examiner stated that Groups I and II were related as process of making and product made, Groups I and III were related as process of making and product made, and Groups II and III were related as subcombinations disclosed as usable together in a single combination.

The claims have been amended several times since the original filing date of this application. In order to determine whether or not the restriction requirement of Apr. 22, 2005 is still proper, the most recent entered claims must be reviewed. Since the amended claims filed in an after final amendment on Oct. 20, 2006 were not entered, the most recent pending claims are to be found in the amendment filed May 31, 2006.

A comparison of claims 1 and 25 reveals that claim 1 requires the positively recited step of placing prewritten discs "around a motor hub". There is no mention of a "motor" in claim 25. Therefore, in accordance with MPEP 806.05(f), the product *as claimed* can be made by another materially different process. In this case, the product as claimed can be made by a materially different process, such as a process which does not require the specific step of placing prewritten discs around a motor hub. In addition, the product can be made in a process wherein each disc is concentrically aligned with respect to each other and wherein the servo tracks are aligned with each other *prior* to placing the discs around a motor hub. Currently, claim 1 requires placing discs having servo tracks that are offset, placing the discs around a motor hub, and biasing each disc to concentrically align the servo tracks.

A comparison of claims 1 and 30 reveals that claim 1 requires the positively recited step of "biasing each disc in a direction of the respective angular reference axis to concentrically align the servo tracks" which is not recited in claim 30. Therefore, in accordance with MPEP 806.05(f), the product *as claimed* can be made by another materially different process. In this case, the product as claimed can be made by a materially different process, such as a process which does not require the specific step of biasing each disc in a direction of the respective angular reference axis to concentrically align the servo tracks. For example, the product can be

made in a process wherein each disc is concentrically aligned with respect to each other and wherein the servo tracks are aligned with each other *prior* to placing the discs around a motor hub. Currently, claim 1 requires placing discs having servo tracks that are offset, placing the discs around a motor hub, and biasing each disc to concentrically align the servo tracks.

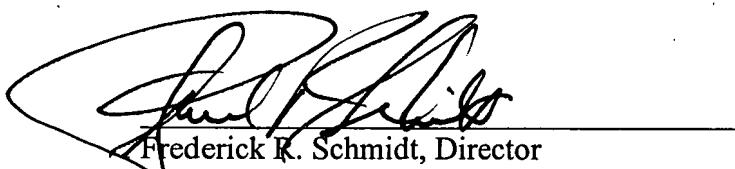
A comparison of claims 25 and 30 reveals that claim 30 requires a motor for a data storage device which is not found in claim 25. Therefore, in accordance with MPEP 806.05(d), the subcombinations are distinct from each other if they are shown to be separately usable. In this case, Group III is separately usable in that it has a motor that is used for a data storage device.

Petitioner's specific request on page 1, last 4 lines of the petition, that there be a showing of one way distinctness by either showing how the process of claim 1 can be used to make a materially different product than claims 25 and/or 30, or how the product of claims 25 and/or 30 can be made by a materially different process than claim 1, has been addressed above.

In view of the record, the restriction requirement rendered in the Office action dated Apr. 22, 2005 and made FINAL on Aug. 22, 2005 is considered proper and stands. Petitioner's request to have non-elected claims 25-33 be examined in this application is dismissed.

Any inquiry regarding this decision should be directed to Marc Jimenez, Training Quality Assurance Specialist, at (571) 272-4530.

The petition is dismissed.



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